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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,214	12/05/2000	Jonathan Miller	13993	9173

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EXAMINER

BORIN, MICHAEL L

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 04/16/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/730,214

Applicant(s)
Miller et al.

Examiner
Michael Borin

Art Unit
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 1, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above, claim(s) 1-21 and 41-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 20) ☐ Other:

Art Unit: 1631

DETAILED ACTION

Status of Claims

1. Claims 1-57 are pending.

Response to restriction requirement filed 03/01/02 is acknowledged. Applicant elected, without traverse, Group II, claims 22-40. Claims 1-21, 41-57 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected groups. Cancellation of claims 1-21, 41-57 is requested.

Information Disclosure Statement

2. Applicants' Information Disclosure Statement filed 01/17/01 has been received and entered into the application. Accordingly, as reflected by the attached completed copies of forms PTO-1449, the cited references have been considered.

Claim Rejections - 35 U.S.C. § 101/ 112-1

The following is a quotation of the 35 U.S.C. § 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

Art Unit: 1631

enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The pending claims have been reviewed in light of the the Utility Examination Guidelines and Guidelines for Examination of Patent Applications under 35 U.S.C. 112, first paragraph, "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1092-1111, Friday, January 5, 2001.

The examiner is using the following definitions in evaluating the claims for utility.

"Specific" - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention.

"Substantial" - A utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities. The following are examples of situations that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use and, therefore, do not define "substantial utilities":

- A. Basic research such as studying the properties of the claimed product itself or the mechanisms in which the material is involved.
- B. A method of treating an unspecified disease or condition. (Note, this is in contrast to the general rule that treatments of specific diseases or conditions meet the criteria of 35 U.S.C. § 101.)
- C. A Method of assaying for or identifying a material that itself has no "specific and/or substantial utility".
- D. A method of making a material that itself has no specific, substantial, and credible utility.
- E. A claim to an intermediate product for use in making a final product that has no specific, substantial, and credible utility.

"Credible" - Credibility is assessed from the perspective of one of ordinary skill in the art in view of the disclosure and any other evidence of record that is probative of the applicant's assertions. That is, the assertion is an inherently unbelievable undertaking or involves implausible scientific principles.

"Well-established" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art.

Art Unit: 1631

See also the MPEP at §§ 2107 - 2107.02.

4. Claims 22-40 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility due to its not being supported by a substantial utility or a well established utility.

The invention is drawn to method for designing proteins by a computational method which determines the optimal low energy configuration of a protein. Hence, the asserted utility of the method is making of proteins. However, there is no factual evidence that the proteins produced by such method have a utility (e.g., have any pharmaceutical utility). No specific examples of the claimed design method are present in the specification. Consequently, no protein having any potential utility is disclosed. The specification does not relate to any "real world" substantial utility of the claimed method. Further characterization of the claimed subject matter would be required to identify or reasonably confirm a "real world" use. Note, that prior art acknowledges that design of proteins is largely unsuccessful. See, e.g., Shakhnovitch:

"Most of the present experimental [protein design] approaches enjoyed only limited success, providing polypeptides that in most cases fold into compact but mostly disordered conformations of molten-globule-like species. It is quite possible that limitations in experimental design result from a relatively low synergism between experiment and theory." p. R45, right column.

The examiner does not find an adequate nexus between the evidence of record and the asserted properties of the claimed subject matter. Identifying use of the

Art Unit: 1631

claimed polypeptide would require carrying out further research. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities. In addition, there is no well established utility known for the method as claimed. Consequently, the claimed subject matter is not supported by substantial or well established utility.

5. Claims 21-40 are also rejected under 35 U.S.C. §112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility, one skilled in the art would not know how to use the claimed invention.

Claim Rejections - 35 USC § 103.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each

Art Unit: 1631

claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 21-40 are rejected under 35 U.S.C. 103(a) as obvious over Balaji et al. (US Patent 5612895) in view of Cohen et al. (US 5,878,373) or Lee et al. (US 5,4212,470).

Balaji teaches method for designing peptide mimetics (claim 19) based on method of predicting a stable tertiary structure of a peptide comprising generating protein backbone configuration using dihedral angles phi, psi (see claim 1, and col. 3, lines 51-61), analyzing and plotting the psi, phi angle distribution (claims 5,6, col. 3, lines 56-61), including other known physical and chemical data, such as bond lengths, electrical forces, etc (claim 8, and col. 14), and determining the state with minimum energy (cols. 4,8). Although the reference does not teach some specific limitations of the instant claims (such as eliminating self-intersecting configurations), the differences would be appear minor in nature, and it would be conventional and within the skill of the bioinformatics art to determine and record all variables resulting in a stable protein conformation and having required spatial configuration. For example, Cohen et al. teach that estimations of hydrophobicity/hydrophilicity are helpful in verification of 3D models determined from angle or energy calculations (see

Art Unit: 1631

col. 17, lines 45-49, and claims 1, 8). Lee et al. teach method of determining peptide 3D structure wherein, after defining backbone angles, interaction between side chains is modeled to result in a lowest energy conformation (see claim 1).

Prior art made of record

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Srivastan et al. (US 5,884,230).

Conclusion.

8. No claims are allowed

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Serial Number: 09/730214

Page 8

Art Unit: 1631

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

April 11, 2002

mlb

MICHAEL BORIN, PH.D
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Michael Borin', written over the printed name.